IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: James P. Elia	)	Group Art Unit: 1647
Serial No.: 09/064,000	)	Examiner: Daniel C. Gamett
Filed: April 21, 1998	)	Confirmation No.: 5311
For: METHOD FOR GROWTH OF SOFT TISSUE	)	

RESPONSE

Sir:

This Response is directed to the January 14, 2010 Office Action (hereinafter referred to as "the Office Action"), wherein it was stated at page 2 of the Office Action that prosecution was reopened in view of Applicant's Appeal Brief filed August 20, 2010 (hereinafter "Appeal Brief"). However, the Patent and Trademark Office (hereinafter "PTO") did not provide any specific reasons to support the withdrawal of the appeal.

Applicant notes that the Office Action appears to basically respond to points raised in the Appeal Brief. Consequently, Applicant is mystified why the appeal needed to have been withdrawn and the already unduly lengthy, time consuming examination procedure perpetuated. Surely, the instant application should have been ripe for a decision on appeal regarding already developed issues. Applicant does not understand why the present PTO Examiner had a need to withdraw the application from appeal and thus compound already developed issues with additional argumentation, especially in view of the numerous office actions and changes in position by the PTO since the filing of this application some twelve years ago. Surely, after such lengthy prosecution history, the PTO should be capable of establishing and maintaining issues in

which it is comfortable to defend and permit to be resolved by the Board of Patent Interferences and Appeals.

This withdrawal marks the third time the PTO has withdrawn the instant application from appeal following the filing of an appeal brief by Applicant. Such series of withdrawals exacerbates, rather than advances, prosecution of the instant application as dictated by the compact prosecution objectives of the PTO. These series of withdrawals have resulted in unnecessary and considerable delays causing onerous expense to both Applicant and the PTO. The uncertain nature of the prosecution of the instant application has involved the creation of many irrelevant issues and changes in positions of the PTO with the resultant effect of obscuring relevant issues and unnecessarily complicating the various grounds of rejection. Similar problems exist within Applicant's related co-pending applications and between the instant application and such applications. It would markedly improve the quality and advance the prosecution for all of these applications if the PTO would adopt and maintain a consistent position between all such applications from which appeals can be taken.

This third withdrawal from appeal of the instant application appears to be part of a pattern directed at this and other related applications of Dr. Elia. For example, appeals were withdrawn by the PTO two times in the prosecution of patent application Serial No. 09/794,456; two times in Serial No. 09/836,750; and two times in Serial No. 10/179,589. This amounts to a total of nine (9) such withdrawals. Such consistent pattern of withdrawals from appeal does not appear to Applicant to be mere coincidence. A further factor that has contributed to the PTO's inability to reach a final position from which Applicant can lodge an appeal is the apparent reference back to and, perhaps, incorporation of, prior office action(s) into the present Office Action without any meaningful identification of which portions of such prior office action(s)

continue to be relied upon. For example, it is not clear in the Office Action that the enablement rejection or portion thereof was maintained for all reasons of record. In view of the extensive prosecution history of this application, there is the obvious need to clearly delineate which portions of prior office action(s) that are currently relied upon by the PTO. In the office action prior to the instant Office Action, this is manifestly evident. Such practice is frowned upon by the PTO for obvious reasons.

As pointed out repeatedly by Applicant in the prosecution of the instant application, the prospective term for such application has already been seriously eroded by the protracted PTO prosecution despite the "Special" status that should have been accorded to such application by the PTO due to its filing date. Should such protracted prosecution continue, it is conceivable that the entire patent term would be exhausted during prosecution and thereby render any appeal moot. Any such situation would constitute a possibly unique event. Surely, neither Applicant nor the PTO would welcome such event as it would represent a failure in the very administrative process established by the PTO, and inviolable of the Administrative Procedures Act ("APA"). The protracted nature of the prosecution history of the instant application is succinctly chronicled in the file of this application—especially in the Petition filed November 5, 2004, and by the multiple appeal withdrawals mentioned above. However, the above situation may be at least minimized somewhat in the future by adherence to PTO prosecution practices, such as following timelines for "Special" applications, engaging in compact prosecution, and discontinuing the above enumerated appeal withdrawal pattern.

In any event, Applicant requests favorable reconsideration for the substantive reasons set forth below.